Supreme Court, U.S.
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No.

In The

# Supreme Court of the United States

October Term, 1997

GOOD NEWS COMMUNICATIONS, INC.,

*Petitioner,*

*vs.*

UNITED STATES PATENT AND TRADEMARK OFFICE,

*Respondent.*

*On Petition for Writ of Certiorari to the United States Court of Appeals for the Federal Circuit*

## PETITION FOR WRIT OF CERTIORARI

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## QUESTIONS PRESENTED

1. Is an *ex parte* applicant entitled to register an element of a registered composite mark in reliance on the benefit of the prima facie evidentiary status of it prior registration for that composite mark under Sections 7(b) and 33(a) of the Trademark Act in subsequent *ex parte* examination proceedings when that element was proven distinctive apart from the other elements of the registered composite mark by submission of evidence under Section 2(f) of the Trademark Act as the record of its prior registration reflects?

2. Is an *ex parte* appliçant entitled to the benefit of established *ex parte* examination procedures as a matter of due process of law in a subsequent application to register an element of the applicant's registered composite mark when there is no evidence of record that the examining attorney met the burden of showing that said element, previously held to have become distinctive under Section 2(f) of the Trademark Act as the record of the prior registration reflects for the composite mark, is being used by any third party as a generic or descriptive term in the relevant trade?

3. In an *ex parte* examination proceeding, is an applicant who owns a registered composite mark, a prior certificate of registration for the mark, and the mark's dominant element, proven distinctive under Section 2(f) as the record of the prior registration reflects, entitled to the protection of the Fifth Amendment to the United States Constitution from: (a) being deprived of its property without due process of law; and/or (b) a taking of its property without just compensation, because the Federal Circuit Court affirmed the Patent and Trademark Office finding that said dominant word element is now unregistrable as generic or merely descriptive when there is no evidence of record that any third party is using said distinctive element as a generic or descriptive term in the relevant trade?

## PARTIES TO THE PROCEEDING

The parties are limited to those named in the caption namely, Good News Communications, Inc. and the United States Patent and Trademark Office.

## STATEMENT PURSUANT TO RULE 29.6

Petitioner has no parent company and no nonwholly owned subsidiaries.

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Petitioner, Good News Communications, Inc. ("Good News"), respectfully requests that a writ of certiorari be issued to review the judgment of the United States Court of Appeals for the Federal Circuit in this case.

## OPINIONS BELOW

The judgment of the United States Court of Appeals for the Federal Circuit is without opinion and unpublished, but the disposition will appear in tables published periodically. *See* Fed. Cir. R. 36. The decisions of the Trademark Trial and Appeal Board ("TTAB") for the U.S. Patent and Trademark Office ("PTO") dated November 13, 1996 and upon reconsideration on January 24, 1997 are not published but can be found in the record of petitioner's appeal to the United States Court of Appeals for the Federal Circuit.

## STATEMENT OF JURISDICTION

The judgment of the United States Court of Appeals for the Federal Circuit ("Federal Circuit Court") was entered December 9, 1997 and affirmed the decisions of the TTAB.

Jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

## CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

The Fifth Amendment to the United States Constitution provides in relevant part: "No person shall . . . be deprived of life, liberty, or property, without due process of law; nor shall private property be taken for public use, without just compensation."

Section 2 of the United States Trademark Act of 1946, as Amended (the "Trademark Act"), 15 U.S.C. § 1052, provides in relevant part:

> No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature . . .
>
> > (e) Consists of a mark which, (1) when used on or in connection with the goods of the applicant is merely descriptive. . . .
> >
> > (f) . . . nothing herein shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Commissioner may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made. . . .

Section 6 of the Trademark Act, 15 U.S.C. § 1056, provides in relevant part:

> (a) The Commissioner may require the applicant to disclaim an unregistrable component of a mark otherwise registrable. . . .
>
> (b) No disclaimer . . . shall prejudice or affect the applicant's or registrant's rights then existing or

> thereafter arising in the disclaimed matter, or his right of registration on another application if the disclaimed matter be or shall have become distinctive of his goods and services.

Section 7 of the Trademark Act, 15 U.S.C. § 1057, provides in relevant part:

> Certificates of Registration
>
> (b) Effect; prima facie evidence. A certificate of registration of a mark upon the principal register provided by this Act shall be prima facie evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate, subject to any conditions or limitations stated in the certificate.

Section 33(a) of the Trademark Act, 15 U.S.C. § 1115(a), provides in relevant part:

> (a) Any registration . . . of a mark registered on the principal register provided by this Act and owned by a party to an action shall be admissible in evidence and shall be prima facie evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the registration subject to any conditions or limitations stated therein, but shall not preclude another person from proving any

legal or equitable defense or defect, including those set forth in subsection (b), which might have been asserted if such mark had not been registered.

## STATEMENT OF THE CASE

Good News owns the registered composite mark MOVIEGUIDE and design and Principal Register Certificate No. 1,741,219 without disclaimer of any element of its composite mark having a dominant word portion and a design component, and bearing the designation "SEC. 2(F)":

As printed, the certificate shows that as of the date of registration, December 22, 1992, the registered composite mark had acquired distinctiveness under Section 2(f) without disclaimer of the dominant feature MOVIEGUIDE. And in 1993, as is common when more than one mark registrable element exists in a composite mark, Good News filed a subsequent application to register the word MOVIEGUIDE only in typewritten form as Good News showed has become distinctive under Section 2(f) in its prior registration.

The Patent and Trademark Office (PTO) examining attorney, however, when Good News presented its prior registration as *prima facie* evidence in its subsequent application that the dominant element of its registered composite mark has become distinctive under Section 2(f), she deemed the prior registration "not relevant" and refused to consider the efficacy of applicant's earlier showing of distinctiveness for the word MOVIEGUIDE only. She therefore refused to register MOVIEGUIDE in typewritten form based on descriptiveness under Section 2(e) of the Act and genericness under Section 2(f) and further held that the applicant's submission of evidence to show distinctiveness under Section 2(f) was insufficient.

Good News argued that the PTO had no authority to destroy any active registration or registered mark under the Trademark Law in *ex parte* examination proceedings; that registration of its mark MOVIEGUIDE in typewritten format would not preclude continued use of the two-word term "movie guide" in the trade; and that the refusal of the PTO to register its distinctive element MOVIEGUIDE violated the protection of the Fifth Amendment of the United States Constitution against deprivation of its property without due process of law and the taking of its property for public use without just compensation.

In response, the examining attorney said that "the applicant has no exclusive right" to the word MOVIEGUIDE only because "it is generic" and "[g]eneric names are in the public domain."

The Trademark Trial and Appeal Board (TTAB) affirmed but modified the examining attorney's refusal to register by finding that the applicant's prior registration had limited relevance only. And solely to the extent of information appearing on applicant's printed prior registration without referring to the entire file wrapper history, which it confirmed is of record in this case, the TTAB held that the previous Good News showing of distinctiveness under Section 2(f) "went to the entire composite mark and not to the word MOVIEGUIDE only" and thus affirmed the examining attorney's refusal to register.

The Federal Circuit Court affirmed the TTAB decision by judgment without a written opinion. The record before this Court is thus the same as that provided to the Federal Circuit Court.

**A. Questions Raised By The Facts.**

A fundamental question raised in this case is whether or not an *ex parte* applicant is entitled to the presumptions of its

registered mark that it is not merely descriptive or generic, or, if merely descriptive, is accorded secondary meaning as the record of its prior registration reflects, in examination proceedings for registration of the dominant feature of its composite mark registered without disclaimer under Section 2(f) as a matter of due process of law.

A significant related question is whether or not the Federal Circuit Court affirmed TTAB finding that applicant's word MOVIEGUIDE only is unregistrable in this case, without the PTO overcoming the presumptions of applicant's prior registration's validity by showing that its distinctive registered dominant feature MOVIEGUIDE is now used by any third party in the trade, and therefore constitutes an impermissible collateral attack on the validity of applicant's registered mark and its registration certificate 1,741,219 because the dominant feature MOVIEGUIDE is now considered an "unregistrable component" under Section 6(a) of the Act thereby invalidating both the composite mark and prior registration under existing trademark law.

Another major related question is whether or not the Federal Circuit Court affirmed TTAB finding that the applicant's earlier registration has a limited *prima facie* evidentiary status because the meaning of its previous Section 2(f) claim "went to the entire composite mark and not to the word MOVIEGUIDE only," and that limited status now allows third party public use in the trade of the word MOVIEGUIDE only as a descriptive word or generic term in the same fashion as the two-word term "movie guide" is currently used in the trade.

To fully appreciate the significance of the issues presented by this case, it is essential to consider the procedural background related to both the applicant's first application from which issued its prior registration and its second application involved in this case.

**B. Background Of Registration Certificate No. 1,741,219.**

In 1985, Good News first used its mark in conjunction with publications on the subject of rating movies and videos in accordance with a Biblical worldview and for producing programs for transmission by radio and television. Good News' goods and services are directed to the relevant consumer group including primarily Christians and other like-minded people interested in viewing and producing wholesome family friendly movies and videos.

In 1992, Good News filed its first application in the PTO to register its composite mark on the Principal Register. The first trademark examining attorney required disclaimer of the composite mark's dominant word portion MOVIEGUIDE apart from its design component because she believed it to be merely descriptive under Section 2(e)(1) of the Trademark Act, and alternatively, generic, which means that a term is incapable of registration under Section 2(f) of the Act because no amount of evidence can show that it has become distinctive. Therefore, she required a disclaimer of the word MOVIEGUIDE only. Otherwise, the entire composite mark would be unregistrable because Section 6(a) precludes the registration of a composite mark where its dominant portion constitutes an unregistrable component of the mark.

To support her refusal to register based on descriptiveness and genericness the word MOVIEGUIDE, the first examining attorney produced many LEXIS/NEXIS citations to demonstrate the extensive third party use of the two-word term "movie guide" in the entertainment media trade to describe a review of a movie or movies that serves to guide the thinking of the person reading or hearing it. At the same time, however, the examining attorney's extensive evidence showed that Good News was the only producer of its unique reviews using the single word MOVIEGUIDE as an indicator of source.

In response, Good News submitted numerous exhibits showing: (a) that the Biblical nature of its reviews was unique with respect to those produced by all other sources in the trade; (b) that its well-defined relevant consumer group being targeted includes Bible-believing Christians and other like-minded people interested in viewing and producing wholesome family friendly movies and videos; and (c) that the targeted relevant consumer group across the nation recognized the word "MOVIEGUIDE" as a source indicator for its products.

On establishing these facts, the first examining attorney withdrew: (a) the grounds of descriptiveness and genericness on which she based her requirement of disclaimer; and (b) her refusal to register Good News' composite mark. Consequently, she allowed publication of the mark for opposition, it passed freely through the opposition period in which others in the trade had the opportunity to oppose its registration, and Good News received its Principal Register Certificate No. 1,741,219, which notes the Section 2(f) claim thereon without any disclaimer of any portion of the mark.

In short, despite widespread third party use of the two-word term "movie guide" in the entertainment media trade to describe a review of a movie that serves to guide the thinking of the person reading or hearing it, Good News established acquired distinctiveness of its mark's dominant word element MOVIEGUIDE under Section 2(f) of the Trademark Act, and Principal Register Certificate No. 1,741,219 issued for its mark MOVIEGUIDE and Design on December 22, 1992 without disclaimer of any portion of its composite mark.

**C. Proceedings Below In This Case.**

A presumption to which a Section 2(f) registration is entitled is that it has acquired secondary meaning as of the date of

registration. Based on this presumption, and on *ex parte* examination procedures established by the PTO Manual of Trademark Examining Procedure (TMEP) and TTAB decisions, Good News filed its second application Serial No. 74/368,375 on March 16, 1993 to register the word MOVIEGUIDE in typewritten form under Section 2(f) as applied to the identical goods and services of its Principal Register Certificate No. 1,741,219.

The second examining attorney, different from the first examining attorney who issued the prior registration, refused to register the applicant's distinctive term MOVIEGUIDE because: (a) the *prima facie* evidentiary status of the prior registration was "not relevant" despite established *ex parte* examination procedure; and (b) the applicant's submission of the same evidence of distinctiveness, deemed sufficient in the record of its first application, is now insufficient despite her failure to cite any evidence of anyone other than Good News using MOVIEGUIDE in the trade either as a descriptive or generic term or as a trademark.

In view of the foregoing beliefs, she refused registration because: (a) applicant's mark is descriptive as applied to the identified goods and services and without sufficient evidence of acquired distinctiveness; or (b) it is generic and thus incapable of being registered. And with a multitude of LEXIS/NEXIS citations, different from those cited by the first examining attorney, she showed only widespread third party use in the trade of the generic two-word term "movie guide," but no third party use of the single word MOVIEGUIDE.

The TTAB affirmed but modified the examining attorney's refusal to register applicant's previously declared distinctive MOVIEGUIDE in typewritten format by finding that the record of the prior registration reflects that the Section 2(f) showing

"went to the entire composite mark and not to the word MOVIEGUIDE only." The details of this finding are discussed below.

On appeal pursuant to its jurisdiction under Section 21 of the Trademark Act, (15 U.S.C. § 1071), the Federal Circuit Court rendered judgment affirming the TTAB decision, without opinion, and produces the following results:

1. The Federal Circuit Court judgment precludes the benefit to *ex parte* applicant, Good News, in subsequent examination proceedings of the presumptions accorded its prior Section 2(f) registration as *prima facie* evidence under Sections 7(b) and 33(a) of the Trademark Act thereby invalidating its registered composite mark and its prior registration for its composite mark.

2. Good News' word MOVIEGUIDE only, proven distinctive under Section 2(f) in its prior registration, is declared unregistrable with no evidence on the record that any third party is using the single word MOVIEGUIDE as a descriptive or generic term in the entertainment media trade

3. Good News' word MOVIEGUIDE only, proven distinctive under Section 2(f) in its prior registration, is declared unregistrable so that it would now be available for public use as a descriptive or generic term along with the existing public use of the two-word term "movie guide."

4. Good News' prior registration is rendered invalid for protecting against unauthorized third party use of its registered mark, in whole or in part, because such third party could raise a defense for alleged infringement based on the Federal Circuit Court judgment in this case which holds that the dominant feature of Good News' composite mark is now unregistrable thereby rendering its composite mark unregistrable under

Section 6(a) of the Trademark Act. This judgment thus also encourages third party use of the two-word term "movie guide" with the design component of its composite mark covered by its now invalidated prior registration producing significant confusion within applicant's targeted relevant consumer group thereby rendering significant damage to Good News' reputation and its continued effectiveness in the trade with respect to its unique reviews in the entertainment media trade.

## REASONS FOR GRANTING THE WRIT

### I.

### THE PETITION SHOULD BE GRANTED BECAUSE THE FEDERAL CIRCUIT COURT HAS RENDERED A DECISION IN AN *EX PARTE* EXAMINATION PROCEEDING AS TO THE FEDERAL QUESTION OF THE BENEFIT TO AN *EX PARTE* APPLICANT TO THE *PRIMA FACIE* EVIDENTIARY STATUS OF THE APPLICANT'S PRIOR PRINCIPAL REGISTER CERTIFICATE UNDER SECTIONS 7(b) AND 33(a) OF THE TRADEMARK ACT WHICH *EX PARTE* PROCEEDING DECISION IS IN CONFLICT WITH INTER PARTES DECISIONS GENERALLY INVOLVING THE VALIDITY OF REGISTERED MARKS AND REGISTRATIONS FOR THOSE MARKS.

A matter crucial to the cause of justice in this case is the understanding of registrability as it relates to a dominant feature of a composite mark under Section 6(a) of the Trademark Act, 15 U.S.C. § 1056(a). The Federal Circuit Court, in *Dena Corp. v Belvedere International Inc.*, 950 F.2d 1555, 21 U.S.P.Q. 2d 1047, 1051, explains what is at the heart of the reason for granting the writ.

> The Lanham Act's disclaimer requirement strikes a statutory balance between two competing trademark principles. On the one hand, it provides the benefits of the Lanham Act to applicants for composite marks with unregistrable components. On the other hand, the Act prevents an applicant from claiming exclusive rights to disclaimed portions apart from composite marks. The applicant's competitors in the same trade must remain free to use descriptive terms without legal harassment . . . By encouraging definition of the rights claimed in a composite mark, the Act discourages unnecessary litigation. . . .
>
> Under traditional disclaimer practice, an applicant with a mark whose nonregistrable component was the most prominent or dominant feature — in effect imparting nonregistrable meaning to the entire mark — could not acquire registration by disclaimer. In other words, an applicant could not win registration by attaching an insignificant element to a nonregistrable mark. One again, the language of section 1056(a) codified this traditional rule. Such a mark, in effect, has no "unregistrable component" because the dominant feature of the mark extends a nonregistrable meaning to the whole. The entire mark becomes nonregistrable.

No issue exists in this case that the word MOVIEGUIDE is a dominant feature of Good News' registered mark MOVIEGUIDE and design. Under section 1056(a), if a dominant feature of Good News' mark, MOVIEGUIDE and design, were deemed generic, Good News' composite mark would be unregistrable and the single word mark "MOVIEGUIDE" unprotectable, even at common law, as a trademark and/or service mark according to the above explanation of current trademark law by the Federal Circuit Court.

During *ex parte* prosecution of Good News' application to register its composite mark, the first examining attorney made final her refusal to register Good News' composite mark unless Good News disclaimed the dominant word portion of its mark as follows:

> The present record, in fact, indicates that the mark "MOVIEGUIDE" is so highly descriptive that it is incapable of identifying the applicant's goods and services and distinguishing them from those of others. . . . Under these circumstances, the examining attorney cannot recommend an amendment to proceed under the Trademark Act Section 2(f), 15 U.S.C. Section 1052(f), or an amendment to the Supplemental Register.
>
> Therefore the applicant must insert a disclaimer of "MOVIEGUIDE" in the application. Trademark Act Section 6, 15 U.S.C. Section 1056. . . .
>
> "MOVIEGUIDE" is neither novel nor incongruous terminology as applied to the applicant's goods; but rather, it is an accurate description as to the applicant's goods and services. Purchasers of the applicant's goods and services would expect, and would in fact receive, information about movies. Because "MOVIEGUIDE" immediately tells something about the goods and services, it is descriptive within the meaning of Section 2(e)(1).

In response, Good News submitted evidence under Section 2(f) and proved that "MOVIEGUIDE" had acquired distinctiveness in the entertainment media trade where the generic two-word term "movie guide" is used to describe a review of a movie that serves to guide the thinking of the person reading

or hearing it. Significantly, the examining attorney found no one in the trade other than Good News who used the single word MOVIEGUIDE as either a descriptive/generic term or as an indicator of source for goods and/or services.

In view of these facts, the first examining attorney: (a) withdrew her refusal to register based on descriptiveness and/or genericness; (b) withdrew her requirement for disclaimer of "MOVIEGUIDE;" and (c) issued Good News' U.S. Registration No. 1,741,219 designating a "SEC. 2(F)" claim without a disclaimer of "MOVIEGUIDE" on the printed certificate of registration. This necessarily means that, even without going any further than the information printed on the registration certificate, it's clear that the dominant word feature of applicant's composite mark is necessarily involved in the Section 2(f) claim as the record reflects. Why? Because according to the Federal Circuit Court's explanation of disclaimer under Section 6(a) quoted above, if the dominant feature MOVIEGUIDE were found unregistrable, it would have to be disclaimed. Otherwise, the entire composite mark would not be registrable. Therefore, the presumption of validity for applicant's prior registration must necessarily include the presumptions that "MOVIEGUIDE" is not generic, and that the Section 2(f) claim of that prior registration includes the distinctiveness of the word element "MOVIEGUIDE" as a dominant feature of its registered composite mark.

This foregoing analysis of applicant's prior Section 2(f) registration is particularly true where, as in this case, the second examining attorney held that MOVIEGUIDE "is generic" and therefore it "is in the public domain" making the one word MOVIEGUIDE available for public use in addition to the acknowledged generic two-word term "movie guide" already available for third party use in the trade to describe reviews of movies of any kind. And despite established *ex parte* examining

procedure for an "in part" Section 2(f) showing, discussed in detail below, the TTAB avoided addressing the presumptions of this "prima facie evidentiary status issue."

Consequently, the TTAB finding is limited to the notion that the Section 2(f) claim designated on applicant's printed certificate without a disclaimer of any portion of its composite mark "went to the entire composite mark and not to the word MOVIEGUIDE only." By so doing, the TTAB simply reiterated and affirmed the second examining attorney's refusal to register the typewritten "MOVIEGUIDE" in view of the numerous citations of LEXIS/NEXIS stories evidencing the use of the two-word term "movie guide" without producing one third party use of "MOVIEGUIDE" in the trade as a descriptive term. (This PTO evidence, of course, verifies that Good News still has substantially exclusive use of "MOVIEGUIDE" as it was required to do in its original Section 2(f) claim that it has become an indicator of source for the targeted relevant consumer group.)

**A. Established Examining Procedure Recognizes Rights Provided By The Act For A Mark Registered On The Principal Register.**

The Trademark Manual of Examining Procedure (TMEP), Section 202.02(a), states in relevant part:

> When a mark has been registered on the Principal Register, the mark is entitled to all the rights provided by the Act.

The rights recognized by the TMEP include the *prima facie* evidentiary status of marks registered on the Principal Register under Sections 7(b) and 33(a) of the Trademark Act as thus recognized by established examining procedure. And therefore such rights should be applied to Good News' prior contestable

registration for Good News to enjoy its entitled benefit of the presumptions of the exclusive right to use the mark as registered on the goods and services specified in the registration, the validity of the registered mark and of the registration of the mark, and a presumption of the registrant's ownership of the mark, that the mark has acquired secondary meaning under Section 2(f) of the Act as indicated on the printed certificate, and that the mark is not a generic name.

The United States Court of Appeals for the Seventh Circuit states the presumptions accorded the *prima facie* evidentiary status of a registered mark under Section 33(a) in an inter partes matter in the decision of *Liquid Controls Corp. v. Liquid Control Corp.*, 802 F.2d 934, 231 U.S.P.Q. 579 (7th Cir. 1986).

> 15 U.S.C. 1115(a) [Section 33(a) of the Act]. This section entitles the plaintiff to a presumption that its registered trademark is not merely descriptive or generic, or, if merely descriptive, is accorded secondary meaning. . . .This presumption may, of course, be overcome by proof of descriptiveness, or by proof of genericness. . . .The burden is on the defendant to overcome the presumption (cited cases omitted).

In the appeal from the TTAB, the applicant is in the position of the plaintiff and the PTO is in that of the defendant. And because the TMEP recognizes the rights of registered marks in *ex parte* examining proceedings, the applicant should be entitled to the benefit of the same presumptions of the validity for a prior Section 2(f) registration as exists in inter partes proceedings. And, therefore, the PTO must overcome these presumptions by producing proof of descriptiveness or genericness of the single word "MOVIEGUIDE," which the applicant showed has become distinctive in its prior Section 2(f) registration.

The trademark law presumptions recognize the distinction between the registered mark itself and the registration granted by the PTO. This is of particular importance in this case because it involves a registered composite mark, a dominant word element feature shown to have become distinctive under Section 2(f), and the certificate of registration. Secondly, the presumption that the mark is not a generic name means that the dominant feature "MOVIEGUIDE" is presumed non-generic. Otherwise, it would had to have been disclaimed for the composite mark to become distinctive and registrable. And the stated presumptions should hold true for this *ex parte* examination proceeding for each of the three different property interests represented by the applicant's prior registration as it would for inter partes proceedings and court litigation.

**B. The PTO Burden Of Overcoming The Presumption Of Validity Of The Applicant's Prior Section 2(f) Registration Must Show That The Circumstances Regarding The Third Party Use Of "MOVIEGUIDE" Have Changed Since The Applicant First Proved That "MOVIEGUIDE" Has Become Distinctive By Submission Of The Evidence Of Use In The Trade.**

The first examining attorney cited only third party use of the two-word term "movie guide" without any showing of third party use of the word MOVIEGUIDE only in the trade. Therefore, the PTO evidence in the first application proved Good News to have substantially exclusive use in the trade of "MOVIEGUIDE" as applied to its unique products provided for its well-defined, targeted relevant consumer group. Good News submitted the same evidence of secondary meaning for "MOVIEGUIDE" in the present case and augmented it with evidence to show that the distinctiveness of its mark continues. And the evidence produced by the second examining attorney in the *ex parte* proceeding for Good News' subsequent

application involve precisely the same issues related to the same dominant feature of the composite mark registered under Section 2(f). Therefore, the burden is on the PTO to now show that the circumstances have changed.

In other words, the PTO should now be required to prove that Good News' distinctive element of its registered mark has become generic by showing third party use of "MOVIEGUIDE" only in the trade to overcome the presumptions of applicant's prior Section 2(f) registration. But, in fact, the PTO evidence in the subsequent *ex parte* examination proceedings proved that the circumstances have not changed thereby failing to overcome the burden of the applicable presumptions of validity of it prior registration.

And because the Federal Circuit Court judgment failed to require the PTO to overcome the burden carried by the presumption of validity for the applicant's prior Section 2(f) registration in its decision, without opinion, for this *ex parte* examination proceeding, it is in conflict with: (a) decisions involving inter partes proceedings and court litigation that do require such a burden for the same presumptions to be overcome; and (b) *ex parte* examining procedure established in the TMEP thereby depriving Good News of its *prima facie* evidentiary rights obtained in its prior registration.

**C. The TTAB Is Without Authority In The TMEP Or Previous Decisions Of Any Kind In Finding That It Can Limit Its Review Of The Record Of Applicant's Prior Registration To The Information Printed On The Published Certificate In Determining The Extent Of The Prior Designated Section 2(f) Claim That Is Made Without Disclaimer Of The Dominant Word Element Of Its Composite Mark.**

Section 1212.02(f) of the TMEP is titled "Section 2(f) Claim in Part (as to a Portion of the Mark)" and provides in relevant part:

> A claim of acquired distinctiveness may apply to a portion of a mark. The applicant must clearly identify the portion of the mark for which distinctiveness is claimed. The methods of establishing acquired distinctiveness and the principles relating thereto are the same whether the claim of distinctiveness pertains to the entire mark or a portion of it.

The TTAB finding that the examining attorney's reasoning based on her evidence produced in the *ex parte* proceeding in this case is contrary to this TMEP examining mandate. Moreover, it conflicts with the actions of the first PTO examining attorney who issued the prior Section 2(f) registration. And the Federal Circuit Court judgment, without opinion, affirms the clearly erroneous TTAB holding that Good News' Section 2(f) claim "went to the entire composite mark and not to the word MOVIEGUIDE only."

The examining attorney had justified her disregard for Good News' principal register certificate for three primary reasons: (a) she considered the registered composite mark to be a substantively different mark from its dominant word portion

standing alone in typewritten form; (b) by considering the question of registrability of applicant's dominant word element feature "on its own merit," she avoided having to deal with the fact that Good News, in its first application, proved that the word "MOVIEGUIDE" has become distinctive under Section 2(f); and (c) the dominant element "MOVIEGUIDE" is generic. She cited no authority in the TMEP or in any decision by the TTAB or any court to support her declarations regarding her disregard for the applicant's prior registration.

The TTAB modified the examining attorney's refusal to register in its decisions dated November 13, 1996 and upon reconsideration on January 24, 1997 is more definitive in not disregarding the prior registration completely but in confirming the "different mark" and "inapplicable 2(f) showing" reasons for disregarding Good News' distinctive mark MOVIEGUIDE. After also altering its own original decision by stating that "the file wrapper history is considered to be part of the record of this appeal," the TTAB says in its decision of reconsideration:

> We hasten to add, however, that we were able to ascertain that the Section 2(f) claim in the prior registration pertained to the entire mark, and not to just the word portion, by a review of the registration certificate only. In connection with the issue of acquired distinctiveness of the registered mark, we reiterate that applicant's section 2(f) claim in its earlier registration went to the entire composite mark and not to the word MOVIEGUIDE only. Neither applicant nor the previous Examining Attorney took the actions as prescribed in Section 1212.02(f) of the *Trademark Manual of Examining Procedure* regarding a Section 2(f) claim for only a portion of a mark.

By reviewing the registration certificate "only," the TTAB: (a) admits its neglect of reviewing the file wrapper history of the prior registration it had just validated as part of this case; (b) admits its failure to review the entire record of the prior registration to determine whether or not the applicant "took the actions as prescribed . . . regarding a Section 2(f) claim for only a portion of a mark;" and (c) fails to account for the lack of a disclaimer of any portion of Good News' registered composite mark in order to properly interpret the information printed on the published prior registration certificate.

The published Principal Register Certificate No. 1,741,219 does bear the distinctive claim designation "SEC.2(F)" without a disclaimer. The TTAB decision thus admittedly ignores the broad extent of the applicant's previous Section 2(f) claim and considers it limited "to the entire composite mark and not to the word MOVIEGUIDE only" *because of an alleged undisclosed defect in printing*! And the TTAB fails to describe what more it believes is required in the printed information and why more is, in fact, required.

Unlike the examining attorney, the TTAB did consider the prior registration "relevant" in the present case as far as it went to determine the extent of applicant's previous Section 2(f) showing. Yet the TTAB still limits the "rights provided by the Act" as stated in TMEP Section 202.02(a) to their interpretation of "only" the printed words appearing on the registration certificate alone. Since the applicant has no control over what the PTO prints on its published registration certificates, it should not be held responsible for some printing defect, undisclosed by the TTAB, but apparently existing in the collective minds of the TTAB. And the only way the TTAB could possibly determine whether or not the applicant "took the actions as prescribed in Section 1212.02(f)" of the TMEP, was to have reviewed its *entire* record, which it admittedly failed to do.

Therefore, the Federal Circuit Court failed to require the TTAB to fulfill its obvious responsibility to examine the file wrapper history on which the applicant has relied throughout the *ex parte* examination proceedings to recognize the true extent of applicant's Section 2(f) claim. Instead, the TTAB is allowed without authority to make an alleged undisclosed printing defect a critically essential and indeed, fatal barrier to any further inquiry into the file wrapper history, to entitle an applicant the benefit of its previous showing of "a Section 2(f) claim for only a portion of a mark."

In other words, according to the TTAB decision below, if such a printing defect exists on the printed principal register certificate, it voids the substantive nature of the extensive evidence submitted by Good News that successfully convinced the first examining attorney to withdraw her requirement to disclaim the word MOVIEGUIDE because, **before** reviewing and analyzing applicant's evidence of acquired distinctiveness, she considered it generic or merely descriptive as applied to applicants products.

A closer look at the specific language of the particular TMEP section relied on by the TTAB in its attempt to justify its limited review of the file wrapper history is instructive. The TTAB argues that "[n]either the applicant nor the previous Examining Attorney took the actions as prescribed in Section 1212.02(f)" of the TMEP regarding the extent of Good News' Section 2(f) claim. TMEP Section 1212.02(f) provides in relevant part:

> Generally, the element which is the subject of the 2(f) claim must present a distinct commercial impression apart from the other elements of the mark. That is, it must be a separable element in order for the applicant to assert that it has acquired distinctiveness as a mark.

> If the examining attorney determines that the claim of distinctiveness as to a portion of the mark is appropriate, *the examining attorney* should ensure that *the record reflects* that the 2(f) claim *applies* to the mark "in part" and that *the relevant portion* of the mark *is specified* (emphasis added).

First, an examination of the entire record is necessary to determine whether or not the applicant's claim presents "a distinct commercial impression" of "a separable element" of the applicant's composite mark. A complete examination of "the record" clearly shows that the applicant made the required showing of the first quoted paragraph.

The second above-quoted paragraph of TMEP Section 1212.02(f) prescribes only what "the examining attorney" is to do with respect the Section 2(f) claim, but prescribes no "actions" whatsoever for "the applicant" to take other than what it did to prove the distinctiveness of the word MOVIEGUIDE only. Therefore, nothing in this TMEP section justifies the TTAB finding that it has authority to limit a Section 2(f) claim of a prior registration solely to a review of the printed information found on the published principal register certificate. Indeed, it is respectfully asserted that a complete review of the file wrapper history is required to determine what "the record reflects" with respect to the extent of the applicant's Section 2(f) claim. And "the record" needs only to reflect that applicant's claim "applies" to the mark "in part" and that "the relevant portion" of the mark "is specified" as was done in this case.

A review of "the record" comprising the file wrapper history of Good News' prior registration Certificate No. 1,741,219 clearly "reflects" that applicant proved by the submission of evidence that its Section 2(f) claim "applies to the mark 'in part' " and that the word MOVIEGUIDE only is "the relevant

portion of the mark" that "is specified" by the Section 2(f) claim that it has become distinctive of the applicant's goods in commerce. The applicant, Good News, should not be held accountable, and in fact deprived of the benefit of its previous extensive 2(f) submission, for what "the previous Examining Attorney," clerical staff person, printer, or other PTO personnel may or may not have done with respect to what is printed on the published Certificate No. 1,741,219 as urged by the TTAB.

In short, Good News should not be deprived of the benefit of the proper extent of it previously established Section 2(f) claim of secondary meaning of its mark MOVIEGUIDE because the TTAB did not review the file wrapper history of its registered mark to determine what the record did in fact reflect. And because the Federal Circuit Court refused to admonish the TTAB for its refusal to uphold established *ex parte* examining procedures in this case thereby failing to give Good News benefit of its previous Section 2(f) showing of acquired distinctiveness, it is respectfully requested that this Court grant this writ for applicant to obtain registration for its distinctive separable word "MOVIEGUIDE" as it is entitled under federal trademark law.

## II.

**THE PETITION SHOULD BE GRANTED BECAUSE THE FEDERAL CIRCUIT COURT HAS DECIDED AN IMPORTANT QUESTION OF FEDERAL TRADEMARK LAW WHICH HAS NOT BEEN, BUT SHOULD BE SETTLED BY THIS COURT BECAUSE THE FEDERAL CIRCUIT COURT AFFIRMED A COLLATERAL PTO ATTACK ON AN EX PARTE APPLICANT'S PRIOR SECTION 2(f) REGISTRATION BY RENDERING UNREGISTRABLE ITS DISTINCTIVE DOMINANT SEPARABLE WORD ELEMENT WITHOUT EVIDENCE THAT THE WORD ELEMENT IS BEING USED DESCRIPTIVELY OR GENERICALLY BY ANY THIRD PARTY IN THE TRADE THEREBY: (a) DEPRIVING THE OWNER OF ITS RIGHTS IN ITS REGISTERED MARK, THE PRIOR CERTIFICATE OF REGISTRATION, AND ITS DOMINANT SEPARABLE ELEMENT; AND (b) TAKING ITS PROPERTY RIGHT IN THE SEPARABLE ELEMENT FOR PUBLIC USE AS A GENERIC OR DESCRIPTIVE TERM WITHOUT JUST COMPENSATION UNDER THE FIFTH AMENDMENT TO THE UNITED STATES CONSTITUTION.**

The Federal Circuit Court decision affirms the TTAB finding that the *ex parte* applicant's mark "MOVIEGUIDE" is generic or merely descriptive despite the lack of evidence showing the third party use of the word "MOVIEGUIDE" in the trade. In so doing, that which was deemed registrable in the *ex parte* applicant's prior Section 2(f) registration is now unregistrable. In accord with the Federal Circuit Court's explanation of Section 6(a) above, the composite mark would be unregistrable in an impermissible collateral attack because if "MOVIEGUIDE" were, in fact, descriptive or generic, it would be an unregistrable dominant feature rendering the entire composite mark unregistrable.

This means that if Good News were to try to enforce any of its rights against an alleged infringer of its registered composite mark, the alleged infringer could produce the Federal Circuit Court decision in this case, and successfully defend itself thereby making use of Good News' distinctive mark "MOVIEGUIDE" as a descriptive or generic term or even in a trademark sense. In other words, the rights in applicant's registered mark are rendered useless by the decision below because Good News is not being given the benefit of the presumptions of its Section 2(f) claim in its prior registration. Consequently: (a) its separable word feature "MOVIEGUIDE" is deemed in the public domain; (b) the dominant word feature of it composite mark is now unregistrable rendering its prior registration invalid because there is no disclaimer of "MOVIEGUIDE" apart from the design component of the mark; and (c) the registration rights it has in its design component are invalidated.

In view of the foregoing, the Federal Circuit Court judgment that the dominant word portion of a registered composite mark, previously proven distinctive under Section 2(f), is now deemed unregistrable as being descriptive or generic without evidence of its use as such by any third party in the trade invalidates the right to register the word portion only, makes it available for public use, and invalidates the composite mark and prior registration for the composite mark and therefore deprives applicant of its property without due process of law and constitutes a taking for public use of all its property rights related to its registered mark and prior registration without just compensation under the Fifth Amendment to the United States Constitution.

## CONCLUSION

Accordingly, Good News respectfully requests that its petition for writ of certiorari be granted.

Respectfully submitted,

NEIL F. MARKVA
*Counsel of Record*
LAW OFFICE OF
NEIL F. MARKVA
*Attorney for Petitioner*
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# APPENDIX

**APPENDIX A — JUDGMENT OF THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT FILED DECEMBER 9, 1997**

**United States Court of Appeals for the Federal Circuit**

97-1332

IN RE GOOD NEWS COMMUNICATIONS INC

**JUDGMENT**

**ON APPEAL from the** UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

**In CASE NO(S).** 74/368,375

**This CAUSE having been heard and considered, it is**

**ORDERED and ADJUDGED:**

PER CURIAM (LOURIE, CLEVENGER, and GAJARSA, *Circuit Judges*):

*AFFIRMED. See* Fed. Cir. R. 36.

**ENTERED BY ORDER OF THE COURT**

s/ Jan Horbaly
Jan Horbaly, Clerk

**DATED** DEC 9, 1997

## APPENDIX B — DECISION OF THE TRADEMARK TRIAL AND APPEAL BOARD OF THE PATENT AND TRADEMARK OFFICE ON RECONSIDERATION DATED JANUARY 24, 1997

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Hearing: February 7, 1996

Paper No. 26
TJQ

Trademark Trial and Appeal Board

In re Good News Communications, Inc.

Serial No. 74/368,375

Request for Reconsideration

Neil F. Markva for applicant.

Meryl L. Hershkowitz, Trademark Examining Attorney, Law Office 12 (Deborah S. Cohn, Managing Attorney).

Before Seeherman, Quinn and Hohein, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

The Board, in a decision dated November 13, 1996, affirmed the refusals to register. Applicant now has requested reconsideration of that decision.

*Appendix B*

We initially wish to clarify our decision with respect to the matter of whether or not the file history of applicant's Registration No. 1,741,219 is of record in this appeal.

Although the file history was not made of record during the prosecution of the application, applicant is correct in asserting that applicant and the Examining Attorney discussed, at same length, the import of the prior registration. More significant, however, is that, upon further review, we note an inconsistency in our opinion. That is, although the Examining Attorney's objection was sustained, the Board essentially considered, later in the opinion (p. 19), the file history.

In view thereof, our decision is modified to the extent that the file wrapper history is considered to be part of the record of this appeal. We hasten to add, however, that we were able to ascertain that the Section 2(f) claim in the prior registrar on pertained to the entire mark, and not to just the word portion, by a review of the registration certificate only. In connection with the issue of acquired distinctiveness of the registered mark, we reiterate that applicant's Section 2(f) claim in its earlier registration went to the entire composite mark and not to the word MOVIEGUIDE only. Neither applicant nor the previous Examining Attorney took the actions as prescribed in Section 1212.02(f) of the *Trademark Manual of Examining Procedure* regarding a Section 2(f) claim for only a portion of a mark.

Given the existence of applicant's prior registration, we are compelled to point out again that our decision regarding the lack of registerability of MOVIEGUIDE in typed form does not constitute an impermissible attack on the prior registration. The prior registered mark consists of the term MOVIEGUIDE plus a design feature; that is, MOVIEGUIDE was only a part of

the whole mark. As indicated in our original decision, we view applicant's typed drawing in the involved application as an attempt to broaden the scope of protection afforded by its registered logo mark. The instant application is not limited to the mark depicted in any special form or lettering style. A registration, if issued, would cover the term per se. In our view, however, applicant is not entitled, despite the existence of the prior registration, to a registration of the designation MOVIEGUIDE per se in typed format. Thus, as discussed in our original opinion, this case is distinguishable from In re The American Sail Training Association, 230 USPQ 879 (TTAB 1986).

We next turn to applicant's other arguments in the request for reconsideration. Applicant contends that its goods and/or services belong to the general category of "movie reviews" and not "movie guides."

We are not persuaded by this argument. We find that applicants goods and/or services clearly fall within the commonly understood meaning of the term 'guide", and that applicant's perceived distinction between the meanings of the terms "guide" and "review" is more a question of semantics than of substance when the registrability of MOVIEGUIDE is considered as applied to applicants specific goods and/or services. The dictionary definition of "guide" ["something (as a guidebook) that provides a person with guiding information"] shows that a "guide" is not as limited in scope and content as applicant would lead one to believe. As the Examining Attorney's evidence demonstrates, similar goods (i.e., publications comprising movie reviews) are commonly referred to as "movie guides."

*Appendix B*

Applicant further contends that the Board has applied applicant's mark "as if it were for goods that are different from those which [applicant] has identified in its application as originally filed." Applicant argues that "[f]or a title of a series of publications to be descriptive, it must be shown that it conveys an immediate idea of the contents of the publications bearing the title as a trademark" and that "[t]he same is true for the name of services involving the production of programs for transmission by radio and television." Applicant asserts that its mark does not describe the content of its goods and/or services because its goods and/or services are not merely movie reviews, but movie reviews having a particular orientation.][1]

In the case of In re Gould Paper Corp., 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987), the Court found SCREENWIPE to be generic for "pre-moistened, anti-static cloth for cleaning computer and television screens." Just as in that case, where the proposed mark was not COMPUTER SCREEN WIPE or TELEVISION SCREEN WIPE, the fact that the mark here is MOVIEGUIDE, rather than BIBLICAL WORLDVIEW MOVIE GUIDE or FAMILY MOVIE GUIDE (examples given by applicant), is of little moment. The fact remains that the class of goods and/or services is "movie guides."

As for applicant's arguments relating to acquired distinctiveness, that is, that MOVIEGUIDE is recognized as a source indicator, we stand by our earlier conclusion that the designation is generic and, thus, incapable or registration. Moreover, even if the designation were capable of identifying source, more substantial evidence would be required to prove

1. Although applicant couches these arguments in terms of descriptiveness, it is important to note that the issue here is one of genericness.

that MOVIEGUIDE had acquired distinctiveness as a trademark. Although applicant's evidence tends to suggest that applicant has enjoyed success and that the designation MOVIEGUIDE has been widely exposed in the marketplace, there is no direct evidence from any members of the relevant purchasing public to show that they perceive and understand that MOVIEGUIDE is a distinctive source indicator.

Decision: The decision dated November 13, 1996 is modified to the extent that the file history of Registration No. 1,741,219 is considered to be part of the appeal record. The request for reconsideration is otherwise denied, and the refusals stand affirmed.

s/ E.J. Seeherman
E. J. Seeherman

s/ T.J. Quinn
T. J. Quinn

s/ G.D. Hohein
G. D. Hohein
Administrative Trademark Judges
Trademark Trial and Appeal Board

24 JAN 1997 [stamped]

## APPENDIX C — DECISION OF THE TRADEMARK TRIAL AND APPEAL BOARD OF THE PATENT AND TRADEMARK OFFICE DATED NOVEMBER 13, 1996

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Hearing: February 7, 1996

Paper No. 24
TJQ

Trademark Trial and Appeal Board

In re Goods News Communications, Inc.

Serial No. 74/368,375

Neil F. Markva for applicant.

Meryl L. Hershkowitz, Trademark Examining Attorney, Law Office 12 (Deborah S. Cohn, Managing Attorney).

Before Seeherman, Quinn and Hohein, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by Good News Communications, Inc. to register the mark MOVIEGUIDE for "publications, namely, books, magazines and teaching materials on the subject of rating movies and videos in accordance with a Biblical worldview" (in International Class 16); and "producing programs for transmission by radio and television" (in

International Class 41),[1] Applicant, pursuant to Section 2(f) of the Trademark Act, claims that its proposed mark has acquired distinctiveness.

The Trademark Examining Attorney has refused registration under Section 2(e)(1) of the Act on the ground that MOVIEGUIDE, when used in connection with applicant's goods and/or services, is generic and, thus, incapable of functioning as a source identifying mark. The Examining Attorney further contends that in view of the generic nature of MOVIEGUIDE, the evidence of acquired distinctiveness submitted by applicant is insufficient to permit registration.

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney submitted briefs. Applicant's counsel and the Examining Attorney appeared at an oral hearing held before the Board.[2]

The issues on appeal are whether the designation MOVIEGUIDE in typed letters is generic for applicant's goods and/or services and, alternatively, if such designation is not regarded as generic, whether it has acquired distinctiveness. With respect to genericness, the Office has the burden of proving genericness by "clear evidence" thereof. In re Merill, Lynch, Pierce, Fenner & Smith, Inc., 828 F.2d 1567, 4 USPQ2d 1141,

1. Application Serial No. 74/368, 375, filed March 16, 1993, alleging dates of first use of May 1985. The application includes a statement that applicant is the owner of Registration No. 1,741,219.

2. Applicant attached evidence to its reply brief. The Examining Attorney, at the oral hearing, objected to this submission as improper. To the extent that any of the materials accompanying the reply brief were not properly made of record during the prosecution of the application, they have not been considered.

1143 (Fed. Cir. 1987). As to acquired distinctiveness, applicant has the burden of proof to establish a prima facie case of acquired distinctiveness. Yamaha International Corp. v. Hoshino Gakki Co., Ltd., 840 F.2d 1572, 6 USPQ2d 1001, 1006 (Fed. Cir. 1988). Evidence of the relevant public's perception of a term may be acquired from any competent source, including newspapers, magazines, dictionaries, catalogs and other publications. In re Leatherman Tool Group, Inc., 32 USPQ2d 1443, 1449 (TTAB 1994), citing In re Northland Aluminum Products, Inc., 777 F.2d 1566, 227 USP2 961, 963 (Fed. Cir. 1985).

The Examining Attorney has introduced over 150 excerpts retrieved from the NEXIS database wherein the term "movie guide" (two words) is used in a generic fashion.[3] We note, at the outset, that several of the excerpts are duplicative or make reference to the same "movie guide" (as, for example, a newspaper's weekly "movie guide"). Further, a few of the excerpts are references to applicant's MOVIEGUIDE publication. The following excerpts from newspapers, magazines and wire-services are representative of the generic usages (i.e., uses not referring to applicant's goods and/or services sold under the designation MOVIEGUIDE made of record by the Examining Attorney:

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3. We take judicial notice of the dictionary definitions of the words "movie" and "guide". University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). The term "movie" is defined as "motion picture" and the term "guide" is defined as n something (as a guidebook, signpost, or instruction manual) that provides a person with guiding information in *Webster's Third New International Dictionary* (1976).

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. . . there has been a groundswell of reference works with more popular appeal, such as encyclopedias and movie-guides . . .
*Sacramento Bee,* August 30, 1993

. . . the summer movie guide . . .
*Radio TV Reports, July 7,* 1993

On Mondays, a family movie guide will become a regular feature in our PG section. Foreign and alternative films will be detailed . . .
*St. Petersburg Times,* May 4, 1993

MOVIE GUIDE: If you're on line with an MPC system (Multimedia PC), don't forget to check out Microsoft's "Cinemania".
*Billboard,* April 10, 1993

. . . the first R-rated film ever included in the Family Movie Guide.
*St. Louis Post-Dispatch,* April 6, 1994

. . . a copy of Leonard Maltin's movie guide at hand . . .
*The Washington Post,* March 25, 1994

A paperback movie guide can give you the lowdown on any title . . . a computerized movie guide . . . computer CD-ROM movie guides . . . Cinemania was the first multimedia movie guide in 1992
*USA Today,* March 17, 1994

Movie guide books already list . . .
*Gannett News Service,* March 2, 1994

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One project under consideration is a movie guide . . .
*PC Week,* February 7, 1994

. . . approached Volokh with an idea for a local movie guide.
*The Ethnic NewsWatch,* February 6, 1994

The Movie Guide lists 3,000 of the most famous pictures ever made and provides a thorough plot synopsis for each.
*The Dallas Morning News,* January 18, 1994

. . . according to one movie guide . . .
*Los Angeles Times,* January 13, 1994

Info Business is expanding its Mega Movie Guide into a multimedia product . . . the disk will contain . . . 60,000 reviews . . .
*Gannett News Service,* January 10, 1994

Microsoft Cinemania . . . An interactive movie guide that allows users to see and hear reviews . . .
*Business Wire,* April 1, 1993

Cinemania movie guide . . .
*The Seattle Times,* March 30, 1993

. . . it says in the movie guide he plays a sleazy, immoral con man . . .
*MIN Media Industry Newsletter,* January 11, *1993*

Following the success of its Cinemania movie guide . . .
*Fortune,* December 28, 1992

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The original movie guide . . .
*The Houston Chronicle,* December 6, 1992

MovieFone, the telephone movie guide and ticketing service . . .
*The Hollywood Reporter,* November 10, 1992

Microsoft's Cinemania interactive movie guide lists over 19,000 films from 1914 to 1991 . . .
*Fortune,* November 2, 1992

. . . a palm-size viewer that plays small disks containing wine and movie guides.
*The New York Times,* December 29, 1991

MovieFone is a free telephone movie guide.
*Entertainment Marketing Letter,* December 1991

Premiere Previews, a summer movie guide that may be spun off . . .
*Advertising Age,* October 7, 1991

. . . a movie guide summarizes it as . . .
*Chicago Tribune*, June 26, 1991

The issue includes a summer movie guide . . .
*The Hollywood Reporter,* June 21, 1991

Consult the Pull-Out Movie Guide (Pages 12-17, this section).
*Los Angeles Times,* February 14, 1991

Italian dictionaries share bookshelf space with Pauline Kael's movie guide . . .
*Regardie's,* January 1991

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Movie Guides on Disc Entertain, Teach
*Chicago Tribune,* May 27, 1994

Family movie guide . . .
*Chicago Tribune, May* 26, 1994

One movie guide calls this . . .
*Gannett News Service,* May 26, 1994

Cinemania '94 marks a very important milestone in the development and availability of movie guides.
*Online Libraries & Microcomputers,* May 1994

It has four years of searchable restaurant reviews, a movie guide . . .
*The Quill,* January 1994

An increasing number of movie and video guides . . .
*Chicago Tribune,* December 9, 1993
I love flipping through movie guides . . .
*PC World,* December 1993

No other movie guide has reviews from three well-known film critics . . .
*US News and World Report,* November 29, 1953

. . . search an electronic movie guide, complete with movie reviews
*The Phoenix Gazette,* October 13, 1993

Microsoft has released the 1994 edition of Cinemania, the interactive movie guide for Windows . . ,
*Daily Variety,* October 14, 1993

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Further, the evidence includes various references to the term "movie guide" as part of a title , a specific publication or software program:

Mega Movie Guide
*Billboard,* January 9, 1993

The Video Movie Guide
*The Houston Chronicle,* December 6, 1992

Variety Movie Guide
*The Houston Chronicle,* December 6, 1992

Banner Blue Movie Guide
*Video Week,* November 16, 1992

The Official Splatter Movie Guide
*Time,* April 27, 1992

Movie Guide for Puzzled Parents
*Los Angeles Times,* March 21, 1991

The Movie Guide
*Boston Business Journal,* March 18, 1991

The Times Family Movie Guide
*St. Petersburg Times,* May 27, 1934

Mick Martin and Marsha Porter's Video Movie Guide 1994
*People,* March 28, 1994

Ted Sennett's On-Screen/Off-Screen Movie Guide
*Video Business,* February 4, 1994

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Revenge of the Creature Features Movie Guide
*The San Diego Union-Tribune,* October 28, 1993

Advanced Multimedia Solutions' Video Movie Guide
*CD-ROM World,* October 1993

The Family Movie Guide
*St. Louis Post-Dispatch,* September 22, 1993

Parent's Movie Guide
*Radio TV Reports,* September 20, 1993

Premiere's Ultimate Summer Movie Guide
*The Boston Globe,* May 19, 1993

Leonard Maltin's 1993 Video Movie Guide
*Video Week,* December 7, 1992

Microsoft Cinemania '94 Interactive Movie Guide
*MacWeek,* January 3, 1994

In addition to the foregoing, the Examining Attorney points to applicant's own publication wherein applicant describes it as follows: "A Family Guide to Movies and Entertainment".

Based on the evidence of record, the Examining Attorney concludes that the purchasing public would perceive the designation MOVIEGUIDE as a generic name for the type of goods and/or services offered by applicant.

Applicant, in response to the refusal to register, has made of record several documents in an attempt to establish acquired

distinctiveness. The original application, signed by Theodore Baehr, applicant's chief executive officer, includes a declaration claiming acquired distinctiveness on the basis of substantially exclusive and continuous use of MOVIEGUIDE as a trademark/service mark for five years preceding the filing date of the application. More specifically, Mr. Baehr attested to use since May 1985. In the application applicant also claims ownership of Registration No. 1,741,219 for the mark shown below

for the identical goods and services as those involved in the present application. The registration issued under Section 2(f).

The following exhibits also are of record: a document captioned "MOVIEGUIDE REPORT" which supplies information about applicant's goods and services; the results of a survey conducted by applicant showing the demographics of readers of applicant's publication; a letterhead showing a list of persons serving on applicant's "board of reference"; a national advertisement for the movie "Beethoven" wherein an excerpt of the movie review from applicant's publication appears; several articles concerning applicant, its activities and Mr. Baehr written by others appearing in various printed publications, with frequent references to applicant's MOVIEGUIDE publication; articles written by Mr. Baehr appearing in various printed publications, all of which reference the author as publisher/editor of "MOVIEGUIDE: A Biblical Guide to Movies and Entertainment"; reprints of movie reviews which appeared in various issues of a certain third-party printed publication; and the 1994 annual edition of MOVIEGUIDE.[4]

4. Applicant, in its April 18, 1994 response and appeal brief, (Cont'd)

*Appendix C*

Applicant contends that the Examining Attorney has not shown that the applied-for mark is generic and/or has not acquired distinctiveness. To the contrary, applicant argues that the above-mentioned evidence establishes that the designation sought to be registered would not be perceived by the relevant public as a generic term for its goods and/or services. Rather, according to applicant, the designation MOVIEGUIDE is recognized as a trademark/service mark which functions to identify the source of applicant's goods and services. Applicant's two main arguments can be summarized as follows: (i) the Examining Attorney's evidence fails to show even one use of the term "movie guide" in the single word format of applicant's designation MOVIEGUIDE; and (ii) the Examining Attorney ignores the validity of applicant's subsisting Registration No. 1,741,219, thereby effectively overruling the of Office's previous ruling that the identical showing of acquired distinctiveness was sufficient to register the mark shown in special form in the prior registration.[5]

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(Cont'd)
points out that the Office registers single word marks formed of two words, citing two registrations. Copies of these registrations were not made of record and, thus, this evidence cannot be considered. In re Classic Beverage Inc., 6 USPQ2d 1383 (TTAB 1986). Further, even if considered, the registrations, which show marks different from the one involved here, would have little probative value on the specific question presented in this case.

5. Applicant makes a few constitutional arguments to which we need not specifically respond. Suffice it to say that the Board is not the proper forum to adjudicate such questions inasmuch as it has no jurisdiction to do so. See Harjo v. Pro Football Inc., 30 USPQ2d 1828 (TTAB 1994); and Zirco Corp. v. American Telephone and Telegraph Co., 21 USPQ2d 1542 (TTAB 1991). See also: In re McGinley, 660 F.2d 481, 211 USPQ 668 (CCPA 1981); and in re Mavety Media Group Ltd., 31 USPQ2d 1923 (Fed. Cir. 1994).

*Appendix C*

The critical issue in genericness cases such as this one is whether members of the relevant public primarily use or understand the term sought to be registered to refer to the genus (category or class) of goods or services in question. In re Women's Publishing Co. Inc., 23 USPQ2d 1876, 1877 (TTAB 1992). Our primary reviewing court has set forth a two-step inquiry to determine whether a mark is generic: First, what is the genus (category or class) of goods or services at issue? Second, is the term sought to be registered understood by the relevant public primarily to refer to that genus (category or class) of goods or services? H. Marvin Ginn Corporation v. International Association of Fire Chiefs, Inc., 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986). Titles of publications are not considered any differently than trademarks or other products, although categorizing publications presents difficulties because publications must depend principally on their titles to convey their character. In re Waverly, Inc., 27 USPQ 1620 (TTAB 1993); and In re Distribution Codes, Inc., 199 USPQ 508 (TTAB 1978).

So as to be clear about the specific nature of applicant's goods and services, we point to applicant's description of itself as a "ministry dedicated to redeeming the values of the media according to biblical principles by influencing media executives and by informing and equipping moral people." In this connection, applicant publishes movie reviews with, in applicant's words, "a Biblical world view." Applicant describes its publication as "A Family Guide to Movies and Entertainment to help you choose which movies are appropriate for you and your family." Applicant goes on to list the contents of each issue:

> * *Detailed reviews* from a biblical perspective of every current movie. MOVIEGUIDE does more

than list the objectionable content: the reviews also discuss the movie's premise, the characters' morals, and the portrayal of the Church and of the world.

* *Pertinent articles* on media topics like: "Absolutes Under Attack" and "The Emmys and Family Values" that will give you insight into the entertainment industry and keep you informed about the media trends.

* *Action steps* that Christians can take to change Hollywood. Every movie review also includes names, addresses and phone numbers of the producers so you can express your concerns directly.

Applicant's movie reviews appear in five formats: printed publication; radio; television; 900 telephone hotlines; and church bulletin inserts.

The evidence of record leaves no doubt, and applicant does not dispute, that "movie guide" (two words) is the name of the class of goods and/or services at issue in this appeal. Clearly, the term "movie guide" is generic for a certain type of publication or category of services offered by applicant, not to mention many others. While we view "movie guide" (two words) as generic, the crux of applicant's argument is that the designation MOVIEGUIDE (telescoped as one word) is not understood by the relevant public to refer primarily to the class of goods or services, namely, "movie guides."

We find that the mere telescoping of the two words "movie guide" to form the typed-letter designation MOVIEGUIDE does

not result in a mark capable of registration. In considering the evidence of record we recognize that there is no generic use of "movieguide" (or "MOVIEGUIDE") as one word. Nonetheless, the clear and, in fact, the only connotation of the applied-for designation is MOVIE GUIDE. Whether shown as two typed words or one telescoped typed word, both versions would be pronounced the same and be viewed as having the same connotation. The matter sought to be registered would be readily understood by relevant consumers as referring to a type or category of publications and/or services, namely, movie guides. Remington Products Inc. v. North American Philips Corp., 892 F.2d 1576, 13 USPQ2d 1444 (Fed. Cir. 1990). In short, consumers would regard the designation MOVIEGUIDE as primarily signifying a movie guide of the types offered by applicant, either in the form of a publication or a review broadcast on television or radio. There is nothing unique or incongruous about the telescoping of "movie guide" into the one-word designation MOVIEGUIDE, nor would the telescoped MOVIEGUIDE have any meaning other than MOVIE GUIDE when used in connection with publications and radio and television production services whose central characteristic is a movie guide. The mere deletion of a space between the typed words "movie" and "guide" is not enough to turn a generic designation into a registrable mark. Cummins Engine Co., Inc. v. Continental Motor Corp., 359 F.2d 892, 149 USPQ 559 (CCPA 1966) [holding TURBODIESEL to be a term which by its very nature conveys such a meaning that it cannot be a trademark]; In re Gould Paper Corp., 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987) [holding SCREENWIPE to be generic for anti-static cloth for clearing compute- and television screens]; Turtle Wax, Inc. v. Blue Coral, Inc., 2 USPQ2d 1534 (TTAB 1987) [WASH-WAX held a generic composite name for a product which simultaneously washes and waxes an automobile

— the combination of these two generic terms into one hyphenated term does not alter the generic significance in view or extensive third-party generic use of "wash and wax."]; Jenkins Publishing Co. v. Metalworking, 129 USPQ 346 (TTAB 1967) [METALWORKING for publications in the metal working field is generic]; and In re Wickerware, Inc., 227 USPQ 970 (TTAB 1985) [WICKERWARE held incapable of functioning as a service mark to identify applicant's mail-order and distributorship services in the field of wicker furniture and accessories]. See also: In re Kalmbach Publishing Co., 14 USPQ2d 1490 (TTAB 1990) [RADIO CONTROL BUYER'S GUIDE for publications is generic]; In re Harcourt Brace Jonavich, Inc., 222 USPQ 820 (TTAB 1984) [LAW & BUSINESS for the services of arranging and conducting seminars in the field of business law is generic]; and In re Conus Communications Co., 23 USPQ2d 1717 (TTAB 1992) [ALL NEWS CHANNEL for television broadcasting and productive services is generic]. Further, with respect to the services, consumers hearing on the television or radio the designation MOVIEGUIDE, which is the phonetic equivalent of "movie guide', would not even be aware of the one-word format of the designation.

The fact that applicant apparently is the only one in the movie review industry to use the designation MOVIEGUIDE as one telescoped typed word is not dispositive. Southwire Co. v. Kaiser Aluminum Chemical Corp., 196 USPQ 566 (TTAB 1977). As noted above, even when MOVIEGUIDE is used as telescoped one-word typed designation, nothing is left to speculation or conjecture about the designation. Simply put, the telescoped typed-letter format here does not transform a generic designation into a trademark and/or service mark which indicates source. Applicant simply has joined the two most

pertinent and individually generic terms applicable to its goods and/or services, and then attempts to appropriate the ordinary compound thus created as its trademark/service mark. However, the term "movie guide" remains as unregistrable in the telescoped compound (one typed word) as if presented in two typed words. In re Wells Fargo & Co., 231 USPQ 95 (TTAB 1586); and In re U.S. Steel Corp., 225 USPQ 750 (TTAB 1985).

One of the main arguments advanced by applicant is based on its ownership of Registration No. 1, 741,219 issued on December 22, 1992. The registered mark is for MOVIEGUIDE, in the special form shown below, for goods and services identical to those listed in the involved application.

The registration indicates that it was issued under Section 2 (f) of the Act. Based on the issuance of the registration, applicant argues (appeal brief , DD. 2 through 7) as follows:

> Appellant established secondary meaning under Section 2(f) for its single word mark MOVIEGUIDE in its previous application and was awarded Registration No. 1,741,279. The Section 2(f) showing of secondary meaning was necessary when the trademark examining attorney in the previous case required disclaimer of Appellant's single word MOVIEGUIDE in the face of numerous articles citing the use of the two word term "movie guide" in the trade. Based on the evidence submitted in the previous case, Appellant showed that its single word mark had become identified in the minds of the

public with the origin of its goods and services, and was appropriately awarded its registration under Section 2(f) without having to disclaim its single word mark MOVIEGUIDE . . .

The [PTO] made a determination that MOVIEGUIDE was not a generic term as of December 22, 1992 when it issued U.S. Registration No. 1, 741, 219. The trademark examining attorney has produced no evidence that Registrant's mark has become generic between the December 22, 1992 issue date of its mark MOVIEGUIDE and the date of the [refusal to register], October 15, 1593, a period of less than ten months . . .

The [PTO] has already acknowledged the efficacy and sufficiency of [applicant's] evidence to prove distinctiveness of the single word mark MOVIEGUIDE by issuing Registration No. 1, 741, 219 involving precisely the same issues. Appellant then filed an application to register MOVIEGUIDE in typewritten form; resubmitting all the same evidence as before together with additional information to show that Appellant's mark still indicated the origin of its goods and services, and that its mark had not become generic since its earlier registration date of December 22, 1992 under Section 2(f) . . .

Because Appellant's single word mark MOVIEGUIDE was registered in the [PTO] by acceptance of proof of secondary meaning under Section 2(f), then this constitutes a strong

> presumption of correctness that the trademark and service mark is valid and registrable by reason of having acquired a secondary meaning denoting source of origin in the registrant of the goods and services being sold thereunder . . .

The Board is not persuaded by applicants arguments. The basic flaw in applicant's analysis is that each application must be separately evaluated. There is no right *ipso facto* to register a term in typed form when the same term is registered in special form. Cf. In re Loew's Theatres, Inc., 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985); and In re Sunmarks Inc., 32 USPQ2d 1470 (TTAB 1994). Stated differently, it is possible to obtain a registration of a logo composite mark, as applicant did, even if the term essentially comprising the mark is generic, so long as the word is displayed in a distinctive lettering or is accompanied by a distinctive design. However, such a special form registration does not give any exclusive right to use the generic term per se in typed form. See: J.T. McCarthy, *McCarthy on Trademarks and Unfair Competition,* 12.12[4] and cases cited thereat ["The only exclusive right from such a 'picture' registration is the use of that exact picture' which happens to spell out the generic name of the goods."].

A review of applicant's prior registration shows that the claim of acquired distinctiveness indeed was made in response to a requirement to disclaim "movieguide' apart from the special form mark shown.[6] However, applicant did not claim acquired

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6. We can only speculate as to the previous Examining Attorney's thoughts in accepting, in lieu of a disclaimer of the term "movieguide', a Section 2(f) claim as to the entire special form mark. We recognize that if the previous Examining Atttorney viewed

(Cont'd)

distinctiveness as to the word MOVIEGUIDE only; rather, the claim, as accurately reflected by the "Sec. 2(f)" notation on the registration itself, went to the entire composite mark.[7] Inasmuch as the Office issued a special form registration to applicant, applicant's rights reside solely in the particular style of display of the mark as registered. Sweats Fashions, Inc. v. Pannill Knitting Co., 833 F.2d 1560, 4 USPQ2d 1793, 1798 (Fed. Cir. 1987). Compare: In re The Wella Corporation, 635 F.2d 845, 196 USPQ 7 (CCPA 1977); and In re Carolyn's Candies, Inc., 206 USPQ 356 (TTAB 1980).

Applicant's typed drawing of the mark represents an attempt to broaden the scope or protection afforded by its logo registered mark. Applicant's typed drawing means that the application is not limited to the mark depicted in any special form or lettering style. Trademark Rule 2.51(e). A typed registered mark covers

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(Cont'd)
MOVIEGUIDE to be generic, then she could have required a disclaimer of the term, notwithstanding the claim of acquired distinctiveness. In re Creative Goldsmiths of Washington, Inc., 229 USPQ 766, 76a (TTAB 1986) ["[I]t is within the discretion of an Examining Attorney to require the disclaimer of an unregistrable component (such as a common descriptive, or generic, name) of a composite mark sought to be registered on the Principal Register under the provisions of Section 2(f)."]. See also: T*rademark Manual of Examining Procedure*, Section 1213.02(b).

7. A claim of acquired distinctiveness may apply to a portion of a mark. *Trademark Manual of Examining Procedure*, Section 1212.02(f). However, this section provides that "[t]he applicant must clearly identify the portion of the mark for which distinctiveness is claimed" and that "the examining attorney should ensure that the record reflects that the Section 2(f) claim applies to the mark 'in part' and that the relevant portion of the mark is specified." It appears that neither action was taken.

all reasonable design variations. See: INB National Bank v. Metrohost Inc., 22 USPQ2d 1585, 1588 (TTAB 1992). A registrant is free to change the type style or display at any time and remain within the protection of the registration because the registration covers the word per se, not any particular form or type style presentation of the word. And that is the problem here; applicant is not entitled to a registration of the designation "movieguide" per se in typed format.

Although the following point was not directly raised by either applicant or the Examining Attorney, in view of applicant's accusation that the instant refusal is an impersonal attack on its registration, we wish to distinguish the present situation from the one presented in the case of In re The American Sail Training Association, 230 USPQ 879 (TTAB 1986). That case involved an application to register the mark RETURN OF THE TALL SHIPS for organizing, arranging and sponsoring sailing races. Applicant already owned an incontestable registration for the mark TALL SHIPS for the identical services. When the Examining Attorney required the applicant to disclaim "Tall Ships" apart from the mark, applicant appealed. The Board reversed the requirement of a disclaimer, relying on the U.S. Supreme Court's decision in Park 'N Fly, Inc. v. Dollar Park and Fly, Inc., 105 S.Ct. 65R, 224 USPQ 327 (1985) holding that one cannot challenge the descriptiveness of a mark that is the subject of an incontestable registration. The Board held that the Examining Attorney could not require a disclaimer of "Tall Ships" inasmuch as it would constitute a collateral challenge to the previously registered (now incontestable) mark.

In the present case, however, applicant's registration is not incontestable. In any event, genericness may be raised at any time. Further, the challenged mark here is in typed form whereas

the registered mark is in special form. This situation is distinguished from the one in the *In re The American Sail Training Association* case wherein the only portion of the new mark (RETURN OF THE TALL SHIPS) that was objectionable was the portion that was already registered per se (TALL SHIPS). That simply is not the case here where the prior registration is not for the term MOVIEGUIDE per se. To reiterate, applicant is attempting to broaden, by way or the present application showing the mark in typed form, the rights afforded by its prior registration. Accordingly, we do not view the refusal as an impermissible attack on applicant's registration.

We acknowledge applicant's concerns and frustrations over the refusal to register here, especially following so closely on the heels of the issuance of its prior registration. While uniform treatment under the Trademark Act is an administrative goal, our task in this appeal is to determine, based upon the record before us, whether applicant's designation in typed form is registrable. As often stated, each case must be decided on its own facts. In this connection, neither the Board nor the present Examining Attorney is bound by the other Examining Attorney's decisions regarding the registrability of the mark shown in the registration (which, again, we emphasize is in special form whereas the designation herein is in typed form).

In finding that the typed designation MOVIEGUIDE is incapable of identifying applicant's goods and/or services and distinguishing them from similar goods and/or services of others, we have considered, of course, all of the evidence touching on the public perception or this designation, including the evidence of acquired distinctiveness. In re Paint Products Co., 8 USPQ2d 1863, 1866 (TTAB 1988).

*Appendix C*

Even if we had not found MOVIEGUIDE in typed form to be incapable of identifying and distinguishing applicant's goods and/or services, we nevertheless would affirm the refusal to register on the ground that applicant's evidence of acquired distinctiveness is insufficient to establish that MOVIEGUIDE has become distinctive through use in commerce.

Although Mr. Baehr attests to use of MOVIEGUIDE as a mark since May 1985, the record is devoid of any figures relating to sales or advertising expenditures under the designation. However, we can glean a bit or information about the extent of use from some of applicant's evidence. One of the specimens of record, a document captioned "MOVIEGUIDE REPORT" dated November 1991, gives information on the number of subscriptions (about 4,000) and sets forth a "suggested donation" for a yearly subscription ($40).[8] Applicant's movie reviews are broadcast on the radio, including on five radio networks comprising thousands of stations and on 309 independent radio stations. The movie reviews also are broadcast on television networks (Trinity Broadcasting Network, Christian Broadcasting Network's Home Net, Grace TV of Peoria, IL. and Acts Network) as well as on several independent television stations. The station totals number in the thousands, with potential viewers, according to the figures listed, in the millions. Applicant's telephone hotline, by which callers can hear brief movie reviews, costs $.95 per minute. Lastly, applicant indicates that it has contacted about fifty churches concerning bulletin inserts advertising applicant's publication.

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8. The document also indicates that a condensed version of the publication is available for publishers to re-print reviews in their own publications. Circulation is listed at 32 copies at a cost of $10 each.

*Appendix C*

As noted earlier in this opinion, the record also includes numerous articles wherein applicant and its MOVIEGUIDE designation is mentioned.

The record would suggest that applicant has enjoyed a good degree of success and that the designation MOVIEGUIDE has been exposed, at least theoretically, to millions of people. However, this evidence, standing alone, demonstrates only the popularity of applicant's goods and/or services offered under the applied-for designation, but not that the relevant consumers of such goods and/or services have come to view MOVIEGUIDE as applicant's source identifying trademark/ service mark. The demographic survey is of no help in showing the public's perception of the designation as a source indicator. Further, there is no evidence that the television broadcasts of applicant's movie reviews would include a visual depiction of the one-word designation MOVIEGUIDE; and, indeed, the radio broadcasts would include only the phonetic equivalent of the generic term "movie guide" such that listeners would not be aware of applicants usage of the words in telescoped form.

Similarly, the publicity, both by way of applicant's efforts and of unsolicited articles, is merely indicative of a possible development of distinctiveness. This evidence, however, is not determinative of the success of this exposure. In re Pennzoil Products Co., 20 USPQ2d 1753 (TTAB 1991). Likewise, the existence of applicant's prior special form registration does not persuade us that the refusal to register MOVIEGUIDE in typed form is in error.

Therefore, assuming MOVIEGUIDE were capable of registration, more evidence than that which has been offered here would be necessary to establish the acquired distinctiveness

of the designation. We find this to be specially the case where, as here, the designation, if not generic, is so highly descriptive. That is to say, the greater the degree of descriptiveness, the greater the evidentiary burden on the user to establish acquired distinctiveness. Yamaha International Corp. v. Hoshino Gakki Co., *supra*; and In re Merrill Lynch, Pierce, Fenner & Smith, Inc., *supra*. See also: Restatement (Third) of Unfair Competition (1993), Section 13, comment e ["The sufficiency of the evidence offered to prove secondary meaning should be evaluated in light of the nature of the designation. Highly descriptive terms, for example, are less likely to be perceived as trademarks and more likely to be useful to competing sellers than are less descriptive terms. More substantial evidence of secondary meaning thus will ordinarily be required to establish their distinctiveness. Indeed, some designations may be incapable of acquiring distinctiveness."]. In sum, the record is devoid of evidence upon which to base the conclusion urged by applicant that consumers perceive and understand the designation MOVIEGUIDE as a distinctive source indicator.

Decision: The refusals to register are affirmed.

s/ E. J. Seeherman
E.J. Seeherman

s/ T.J. Quinn
T.J. Quinn

s/ G.D. Hohein
Administrative Trademark Judges
Trademark Trial and Appeal Board

13 NOV 1996

**APPENDIX D — PRINCIPAL REGISTER CERTIFICATE NO. 1,741,219 ISSUED DECEMBER 22, 1992**

U.S. DEPARTMENT OF COMMERCE
United States Patent and Trademark Office

Int. Cls.: 16 and 41

Prior U.S. Cls.: 38 and 107

**United States Patent and Trademark Office**

Reg. No. 1,741,219

Registered Dec. 22, 1992

TRADEMARK
SERVICE MARK
PRINCIPAL REGISTER

GOOD NEWS COMMUNICATIONS, INC. (NEW YORK CORPORATION)
2876 MABRY ROAD N.E.
ATLANTA, GA 30319

FOR: PUBLICATIONS; NAMELY, BOOKS, MAGAZINES AND TEACHING MATERIALS ON THE SUBJECT OF RATING MOVIES AND VIDEOS IN ACCORDANCE WITH A BIBLICAL WORLDVIEW, IN CLASS 16 (U.S. CL. 38)

FIRST USE 5-0-1985; IN COMMERCE 5-0-1985

*Appendix D*

FOR: PRODUCING PROGRAMS FOR TRANSMISSION BY RADIO AND TELEVISION, IN CLASS 41 (U.S. CL. 107).

FIRST USE 5-0-95; IN COMMERCE 5-0-1985

SEC. 2(F)

SER. NO. 74–073,873. FILED 6-28-1990.

CORA ANN MOORHEAD, EXAMINING ATTORNEY

## APPENDIX E — CONTENTS PAGE OF THE FILE WRAPPER OF TRADEMARK APPLICATIONS AND PRINCIPAL REGISTER CERTIFICATE #1,741,219

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

Appeal No. 97-1332

In re GOOD NEWS COMMUNICATIONS, INC.
Serial Number 74/368, 375
Filed March 16, 1993
Registration Number 1,741,219
Filed June 28, 1990
For: MOVIEGUIDE

**CORRECTED NOTICE FORWARDING CERTIFIED LIST**

Notice of appeal to the United States Court of Appeals for the Federal Circuit was timely filed on March 21, 1997, in the Patent and Trademark Office in connection with the above-identified trademark application and registration. Pursuant to 35 U.S.C. § 1071 (a) (3) and Federal Circuit Rule 17 (b) (1), a certified list was sent to the court on April 29, 1997. The initial certified list was incomplete, therefore, a corrected certified list is this day being forwarded to the Federal Circuit.

A copy of the corrected certified list is also this day being forwarded to counsel for appellant in an envelope addressed as follows:

Neil F. Markva, Esq.
8322-A Traford Lane
Springfield, VA 22152

*Appendix E*

Kevin T. Kramer (703-305-8704) and Linda Moncys Isacson (703-308-5233) are the attorneys assigned to represent the Commissioner in this appeal. Counsel for appellant must contact Mr. Kramer or Ms. Isacson to arrange for designating the appendix. See Federal Circuit Rule 30.

All papers to be served on the Solicitor in connection with this appeal shall be delivered as follows:

By hand to: Office of the Solicitor
Crystal Park II
Room 918
2121 Crystal Drive
Arlington, Virginia 22202

By mail to: Office of the Solicitor
P.O. Box 15667
Arlington, Virginia 22215

Respectfully submitted,

BRUCE A. LEHMAN
Commissioner of Patents
and Trademark

Date: July 9, 1997

By: s/ Patricia D. Thomas-Jackson
Patricia D. Thomas-Jackson
Paralegal Specialist
P.O. Box 15667
Arlington, Virginia 22215
703-305-9035

*Appendix E*

U.S. DEPARTMENT OF COMMERCE
United States Patent and Trademark Office

July 9, 1997
(Date)

THIS IS TO CERTIFY that the annexed is a true copy from the records of this office of the "Contents" page of the file wrapper of the trademark application identified below, said "Contents" page being a list of the papers comprising the record before the United States Court of Appeals for the Federal Circuit in the matter of

The Trademark Application of

GOOD NEWS COMMUNICATIONS, INC.

TRADEMARK SERIAL NUMBER 74/368,375

FILED MARCH 16, 1993

and

TRADEMARK REGISTRATION NUMBER 1,741,219

FILED JUNE 28, 1990

By authority of the
COMMISSIONER OF PATENTS
AND TRADEMARKS
s/ Patricia D. Thomas-Jackson
*Certifying Officer*

*Appendix E*

**74/368378**

**CONTENTS**

| Entry | Date | Initials |
|---|---|---|
| 1. | JUN 30 1993 | |
| 2. L&R | 7/28/93 | |
| 3. | AUG 24 1993 | |
| 4. | OCT 15 1993 | |
| 5. Ltr. specs | 4-18-94 | |
| 6. | | |
| 7. | MAY 17 1994 | |
| 8. | JUN -7 1994 | |
| 9. L&R | 11-17-94 | |
| 10. | DEC 22 1994 | |
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| 12. Appeal to Board | 12-6-94 | |
| 13. Appeal Ack'd; Brief due 5-1-95 | 3-1-95 | |
| 14. Appeal Brief | 5-2-95 | |
| 15. To Ex for Statement (7-17-95) | 5-18-95 | |
| 16. Examiner's Brief | 7-14-95 | |
| 17. Req to accept late reply brief | 8-10-95 | |
| 18. Reply Brief | 8-10-95 | |
| 19. Req for Oral Hearing | 8-10-95 | |
| 20. #17 Approved | 8-18-95 | |
| 21. Oral Hearing Set 11-14-95 | 10-3-95 | MGR |
| 22. | 9-12-95 | |
| 23. Oral Hearing Rescheduled 2-7-95 | 11-21-95 | MGR |
| 24. [illegible] dec. | 11-13-96 | MGR |
| 25. Req for Recons to the Bd's Dec. | 12-16-96 | |
| 26. Req for Recon affirmed | 1-04-97 | MGR |
| 27. Notice of Appeal to CAFC | 3/21/97 | |

*Appendix E*

**74/073873**

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| Entry | Date | Initials |
|---|---|---|
| 1. | illegible | |
| 2. | FEB 28 1991 | |
| 3. Amdt A Notice of Revocation of Attorney | 2/1/91 | JW |
| 4. | AUG 22 1991 | |
| 5. Amdt B | 9/3/91 | JW |
| 6. | SEP 18 1991 | |
| 7. | NOV 18 1991 | |
| 8. Appeal to Board | 5-19-92 | KPF |
| 9. Response | 5-19-92 | KPF |
| 10. App & Response Ack — Remanded to Exmr. | 7/6/92 | KPF |
| 11. N OF P | | |